

In the Claims:

C1 8. (Twice amended) A herbicidal composition as claimed in claim 1, which comprises as Component B) at least one herbicide from the group B-b), consisting of acetochlor, alachlor, atrazine, bromoxynil, carfentrazone-ethyl, dicamba, diflufenzopyr, dimethenamide, flufenacet, flumetsulam, fluthiacet-methyl, halosulfuron, imazamox, imazapyr, imazaquin, imazethapyr, iodosulfuron, metolachlor, metosulam, metribuzin, nicosulfuron, pethoxamide, pendimethalin, primisulfuron, prosulfuron, pyridate, rimsulfuron, thenylchlor, thifensulfuron-methyl, tritosulfuron and N-[(4,6-dimethoxypyrimidin-2-yl)-aminocarbonyl]-2-dimethylaminocarbonyl-5-formylaminobenzenesulfonamide.

Cancel claim 17 without prejudice or the intention of creating estoppel.

REMARKS

The invention provides for synergistic herbicidal combinations comprising specific hydroxylphenylpyruvate dioxygenase inhibitors in combination with at least one second herbicide belonging to one of four classes of herbicides.

The indication by the Examiner that he will search additional species if the elected species is determined to be allowable is noted.

It is believed that no fee is required for the consideration of the paper. If, however, a fee is required, the Assistant Commissioner is authorized to charge such fee, or credit any overpayment, to Deposit Account No. 50-0320.

This Amendment corrects the spelling of metolachlor in claim 8 and cancels claims 17, without prejudice or the intention of creating estoppel, as it is directed to non-statutory subject matter. Since claim 16 presents the same subject matter as recited in claim 17, but in statutory form, the cancellation of claim 17 does not affect the scope of the patent protection originally sought.

Claim 17 stands rejected under 35 USC § 101 for being directed to non-statutory subject matter. The cancellation of this term renders this rejection moot and its withdrawal is requested.

Claims 1 to 5, 8, 9 and 14 to 19 stand rejected under 35 USC § 103(a) for allegedly being unpatentable over the combined teaching of Lee *et al.* ("Lee"), De Gennaro *et al.*, U.S. 6,046,134 ("De Gennaro") and Nippon soda, JP-230301 ("Japanese patent"). As none of these prior publications disclosed the elected hydroxylphenylpyruvate dioxygenase inhibitor, Applicants urge that the rejection does not establish a *prima facie* case of obviousness. Moreover, even if it were so held, Applicants urged that the data, appended hereto, overcomes a holding of obviousness. Accordingly, reconsideration and withdrawal of this rejection is requested.

The rejection relies upon the teachings of Lee to disclose that triketone herbicides are known in the art as inhibitors of hydroxylphenylpyruvate dioxygenase and relies on the teaching of De Gennaro and the Japanese patent to disclose synergistic herbicidal combinations of a triketone herbicide with various secondary herbicides, including nicosulfuron (see Office Action at 4). From these teaching the rejection concludes that it "would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have combined the triketone herbicides with sulfonylurea herbicides because each class of herbicides was known and it is *prima facie* obvious to combine herbicidal agents" relying on the decision in *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980). Office Action at 4.

Applicants respectfully disagree that the rejection establishes a *prima facie* case of obviousness. None of the prior publications discloses the triketone compounds provided for in the instant claim as the compounds disclosed therein differ in the Z group. As the rejection

has not demonstrated herbicidal combinations comprising these compounds exhibit synergistic herbicidal activity, it does not establish a *prima facie* case of obviousness.

Moreover, even if it were so held, it is urged that the data appended hereto establish that the elected composition exhibits unexpected properties. The data demonstrate that the elected composition shows synergy when compared with the individual components for combatting POROL and SORHA. Applicants are in the process of placing the data in declaration form.

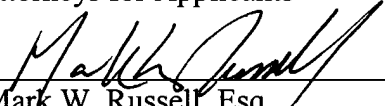
Thus, in view of the foregoing, it is urged that Applicants have demonstrated that the elected combination exhibits unexpected results and the withdrawal of this rejection is respectfully submitted.

Favorable action is earnestly solicited.

Respectfully submitted,

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APPENDIX SHOWING AMENDMENTS TO THE APPLICATION

In the Claims:

8. (Twice amended) A herbicidal composition as claimed in claim 1, which comprises as Component B) at least one herbicide from the group B-b), consisting of acetochlor, alachlor, atrazine, bromoxynil, carfentrazone-ethyl, dicamba, diflufenzopyr, dimethenamide, flufenacet, flumetsulam, fluthiacet-methyl, halosulfuron, imazamox, imazapyr, imazaquin, imazethapyr, iodosulfuron, metolchlor [metoachlor], metosulam, metribuzin, nicosulfuron, pethoxamide, pendimethalin, primisulfuron, prosulfuron, pyridate, rimsulfuron, thenylchlor, thifensulfuron-methyl, tritosulfuron and N-[(4,6-dimethoxypyrimidin-2-yl)-aminocarbonyl]-2-dimethylaminocarbonyl-5-formylaminobenzenesulfonamide.